

Serial No.: 09/690,199
Response to Office Action of 06/22/2005

Docket No. 1005.7
Customer No. 000053953

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1-8, 15 and 22 have been amended, in response to the rejection under 35 U.S.C. § 112, second paragraph. Claims 1-24 are pending. No new matter has been entered.

Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

Rejection of the claims

The Office Action rejected claims 1, 8 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,486,895 ("Robertson").

As amended, claim 1 recites:

1. A method performed by a computer system, comprising:
storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of a hardcopy version of the paper; and
in response to content of a portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the electronic version, wherein the hyperlink reference is associated with an operation of the computer system and with the portion of the likeness, such that when the electronic version is displayed on the display device as the likeness of the hardcopy version, the hyperlink reference's associated portion of the likeness is selectable by a user to cause the computer system's performance of the hyperlink reference's associated operation, and wherein the content is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; a phrase; and a reference.

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As amended, claim 8 recites:

8. A system, comprising:
a computing device for:

storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of a hardcopy version of the paper; and
in response to content of a portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the electronic version, wherein the hyperlink reference is associated with an operation of the computing device and with the portion of the likeness, such that when the electronic version is displayed on the display device as the likeness of the hardcopy version, the hyperlink reference's associated portion of the likeness is selectable by a user to cause the computing device's performance of the hyperlink reference's associated operation, and wherein the content is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; a phrase; and a reference.

As amended, claim 15 recites:

15. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:

store an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of a hardcopy version of the paper; and
in response to content of a portion of the likeness, form a hyperlink reference and embed the hyperlink reference within the electronic version, wherein the hyperlink reference is associated with an operation of the computer system and with the portion of the likeness, such that when the electronic version is displayed on the display device as the likeness of the hardcopy version, the hyperlink reference's associated portion of the likeness is selectable by a user to cause the computer system's performance of the hyperlink reference's associated operation, and wherein the content is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; a phrase; and a reference; and
an apparatus from which the computer program is accessible by the computer system.

In MPEP § 2131, the PTO provides that:

"[t]o anticipate a claim, the reference must teach every element of the claim...."

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Therefore, to sustain a rejection of claim 1, Robertson must contain all of the above-recited elements in claim 1. However, Robertson fails to teach the combination of elements in amended claim 1.

For example, claim 1 recites (in part), “A method performed by a computer system, comprising...in response to content of a portion of the likeness, forming a hyperlink reference and embedding the hyperlink reference within the electronic version” (emphasis added). Unlike claim 1, Robertson fails to teach that a computer system: (a) forms a hyperlink reference in response to content of a portion of a likeness of a hardcopy version of a paper; and (b) embeds the hyperlink reference within an electronic version of the paper. Instead, Robertson assumes that links already exist (e.g., links that can be manually formed and embedded, versus links that are formed and embedded by a computer system).

At col. 4, lines 10-13, Robertson states, “A list of linked documents can be created in various ways. One such way is to follow the relative links on a ‘home page’. Another way would be to create the list manually by traversal through pages on the Web.” Nevertheless, in the first case, where Robertson teaches “to follow the relative links on a ‘home page.’” such teaching assumes that such links already exist on the home page, and Robertson fails to teach how such links were originally formed and embedded. Likewise, in the second case, where Robertson teaches “to create the list manually by traversal through pages on the Web,” such teaching assumes that links already exist on such pages, and Robertson fails to teach how such links were originally formed and embedded.

Consequently, such a statement in Robertson describes a manner of traversing links that already exist, but it fails to teach how such links were originally formed and embedded. Accordingly, Robertson fails to teach the combination of elements in amended claim 1, and Robertson therefore fails to support a rejection of amended claim 1 under 35 U.S.C. § 102(e).

In relation to amended claims 8 and 15, Robertson is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, “...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...” Also, MPEP § 2142 states: “...the examiner must step backward in time

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and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole.’” Further, MPEP § 2143.01 states: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

In relation to claim 1, Robertson is defective in establishing a prima facie case of obviousness. As between Robertson and Applicant’s specification, only Applicant’s specification teaches the combination of elements in amended claim 1. Accordingly, the PTO’s burden of factually supporting a prima facie case of obviousness has not been met.

In relation to amended claims 8 and 15, Robertson is likewise defective in establishing a prima facie case of obviousness.

Thus, a rejection of amended claims 1, 8 and 15 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 8 and 15.

Dependent claims 2-7 and 22 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 9-14 and 23 depend from and further limit claim 8 and therefore are allowable.

Dependent claims 16-21 and 24 depend from and further limit claim 15 and therefore are allowable.

An early formal notice of allowance of claims 1-24 is requested.

To the extent that this Accompanying Amendment results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

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Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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